

Docket No.: 98 P 7649 US 01
App. No.: 09/148,533

REMARKS

Claims 1-11, 17-24 and 26 are pending in the Application.

Claim Rejections - 35 U.S.C. § 102

The Patent Office rejected claims 1, 4, 7, 10, 19 and 22 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,517,413 by Pavitt, Jr. ("Pavitt"). Applicants respectfully traverse this rejection.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Further, "anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Applicants respectfully submit that claims 1, 4, 7, 10, 19 and 22 include elements which have not been disclosed or suggested by Pavitt.

For example, claim 1 recites an element of "said switching circuit connecting said microphone connector to said alternative device connector when the voltage sensed on said telephone line is less than said predetermined threshold voltage" (emphasis added). In rejecting claim 1, the Patent Office has alleged that this element is disclosed by column 3, lines 5-37 and the figure of Pavitt (Office Action, page 3, lines 1-4). Applicants respectfully disagree.

Pavitt recites at column 3, lines 32-37:

Resumption of transcription work with the present invention may be accomplished either by pressing the manual reset button 58 on the control box 16, or if the reset circuitry is included as described above, the resetting will be accomplished automatically upon the termination of the call. (emphasis added)

Thus, according to Pavitt, to resume transcription work (i.e., to achieve switching after the termination of the call), either the manual reset button 58 has to be pressed or the reset circuitry will automatically accomplish the resetting. By manually depressing the reset button 58, the resetting is not accomplished "when the voltage sensed on said telephone line is less than said predetermined threshold voltage", as

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recited in claim 1. The function of the reset circuitry is described at column 2, line 62 to column 3, line 4 of Pavitt:

However, it would also be possible to include a circuit (not shown), which is responsive to the termination of the call, as manifested by a change in current in lines 40, 48 to de-energize the coil 54 holding closed the switch 54a, whereupon the latter would open the circuit supplying current to the relay 34 and cause the switches 36, 38 to shift back to their respective first and normal positions to open the connection of the headset 14 to the telephone circuit box 10, and close the transcriber footswitch line 80 to enable the transcriber again to become operative.
(emphasis added)

In other words, Pavitt's reset circuitry, instead of sensing the voltage on the telephone lines 26 and responding to the change in the sensed voltage as recited by claim 1, accomplishes the resetting in response to a change in current in lines 40, 48, which connects arm 36 to the telephone circuit box 10 and the headset microphone 30 to the telephone circuit box 10, respectively (see the figure of Pavitt).

Based on the foregoing described reasons, Applicants respectfully submit that an element of claim 1 has not been taught, disclosed or suggested by Pavitt. Thus, claim 1 should be allowed.

Claims 4, 7, 10, 19 and 22 were rejected based on the same reasons as applied to claim 1. Since claim 1 is allowable, these claims should also be allowed.

Claim Rejections - 35 U.S.C. § 103

The Patent Office rejected claims 2, 3, 5, 6, 8, 9, 11, 17, 18, 20, 21, 23, 24 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Pavitt in view of well known prior art. Applicants respectfully traverse this rejection.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." (emphasis added) (MPEP § 2143). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. (emphasis added) *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

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As indicated above, independent claims 1, 4, 7, 10, 19 and 22 each include an element not taught, disclosed or suggested by Pavitt or well known prior art, individually or in combination. Thus, dependent claims 2, 3, 5, 6, 8, 9, 11, 20, 21, 23 and 24 should be allowed.

In rejecting claim 17, the Patent Office first correctly admitted that "Pavitt fails to disclose switching in response to a first and second voice command" (Office Action, page 4, lines 20-21). Then, the Patent Office went on to allege that "the examiner takes official notice of the fact that it was well know[n] in the art to provide switching in response to a first and second voice command" (Office Action, page 4, lines 21-22). Applicants respectfully disagree.

As the Patent Office is well aware, Applicants are required to seasonably challenge statements by the Office that are not supported on the record. M.P.E.P. §2144.03. Further, it is noted that "Official Notice" is to be limited to instances where the facts are "capable of instant and unquestionable demonstration as being well-known". M.P.E.P. §2144.03. This is not the present situation. First, in accordance with M.P.E.P. §904 it is presumed that a full search was conducted and this search is indicative of the prior art. The search failed to disclose a reference which would teach or suggest modifying Pavitt to achieve the present invention wherein switching in response to a first voice command and a second voice command occurs. Consequently, the search revealed that the asserted substitution is not well-known and therefore is not entitled to be relied upon in order to reject the present claimed invention. If the Patent Office is unable to provide such a reference, and is relying on facts based on personal knowledge, Applicants hereby request that such facts be set forth in an affidavit from the Examiner under 37 C.F.R. 1.104(d)(2). Absent substantiation by the Examiner, it is respectfully requested that the rejection of claim 17 under 35 U.S.C. § 103 be withdrawn.

Claim 26 was rejected based on the same reasons as applied to claim 17. Since claim 17 is allowable, Claim 26 should also be allowed. Claim 18 should also be allowed due to its dependence upon claim 17.

Double Patenting

Claims 1-11 and 19-24 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S.

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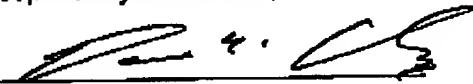
Patent No. 6,091,812 to Iglehart et al. Enclosed please find a terminal disclaimer in compliance with 37 CFR 1.321(c) to overcome this rejection.

Conclusion

Applicants respectfully submit that all pending claims are allowable, and it is respectfully requested that the entire application now be passed to formal allowance.

Respectfully Submitted,

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David D. Chung
Reg. No. 38,409
Phone: (650) 694-5339
Fax: (650) 968-4517

Correspondence Address
Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, NJ 08830